



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/564,277	06/07/2006	Daria Onichtchouk	WEICKM-0051	7320
23599 7590 06/11/2008 MILLEN, WHITE, ZELANO & BRANIGAN, P.C. 2200 CLARENDON BLVD. SUITE 1400 ARLINGTON, VA 22201				
EXAMINER SAOUD, CHRISTINE J				
ART UNIT		PAPER NUMBER		
1647				
MAIL DATE		DELIVERY MODE		
06/11/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/564,277

Applicant(s)

ONICHTCHOUK, DARIA

Examiner

Christine J. Saoud

Art Unit

1647

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 37-58 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 37-58 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/55/08)
Paper No(s)/Mail Date ____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

Art Unit: 1647

DETAILED ACTION

A preliminary amendment was filed 11 January 2006. Claims 1-36 have been canceled and claims 37-58 have been added.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 37, 41, 44-47, 55, and 58, drawn to a composition comprising DG153 protein, method to make a medicament of DG153 protein and kits comprising said protein.

Group II, claim(s) 37, 41, 44-47, 55, and 58, drawn to a composition comprising DG177 protein, method to make a medicament of DG177 protein and kits comprising said protein.

Group III, claim(s) 37-47, 50, 54, 56 and 58, drawn to a composition comprising a nucleic acid encoding DG153 protein, method to make a medicament of nucleic acid molecule encoding DG153 protein and kits comprising said nucleic acid molecule.

Group IV, claim(s) 37-47, 50, 54, 56, and 58, drawn to drawn to a composition comprising a nucleic acid encoding DG177 protein, method to make a medicament of nucleic acid molecule encoding DG177 protein and kits comprising said nucleic acid molecule.

Group V, claim(s) 37, 44-47, drawn to a composition comprising an effector of a nucleic acid encoding DG153 protein, method to make a medicament of an effector of a nucleic acid molecule encoding DG153 protein and kits comprising said effector molecule.

Art Unit: 1647

Group VI, claim(s) 37, 44-47, drawn to a composition comprising an effector of a nucleic acid encoding DG177 protein, method to make a medicament of an effector of a nucleic acid molecule encoding DG177 protein and kits comprising said effector molecule.

Group VII, claim(s) 37, drawn to a composition comprising an effector of DG153 protein, method to make a medicament comprising an effector of DG153 protein, and kits comprising said effector molecule.

Group VIII, claim(s) 37, drawn to a composition comprising an effector of DG177 protein, method to make a medicament comprising an effector of DG177 protein, and kits comprising said effector molecule.

Group IX, claim(s) 48, drawn to a method of using a DG153 nucleic acid for identifying a substance which interacts with a DG153 nucleic acid molecule.

Group X, claim(s) 48, drawn to a method using a DG177 nucleic acid for identifying a substance which interacts with a DG177 nucleic acid molecule.

Group XI, claim(s) 48, 51-53, drawn to a method of using a DG153 protein for identifying a substance which interacts with a DG153 protein.

Group XII, claim(s) 48, 51-53, drawn to a method of using a DG177 protein for identifying a substance which interacts with a DG177 protein.

Group XIII, claim(s) 48, drawn to a method of using a DG153 effector for identifying a substance which interacts with a DG153 effector.

Group XIV, claim(s) 48, drawn to a method of using a DG177 effector for identifying a substance which interacts with a DG177 effector.

Group XV, claim(s) 49 and 57, drawn to a transgenic animal which has increased DG153 expression and method of making.

Group XVI, claim(s) 49 and 57, drawn to a transgenic animal which has decreased DG153 expression and method of making.

Group XVII, claim(s) 49 and 57, drawn to a transgenic animal which has increased DG177 expression and method of making.

Group XVIII, claim(s) 49 and 57, drawn to a transgenic animal which has decreased DG177 expression and method of making.

The inventions listed as Groups I-XVIII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the

Art Unit: 1647

same or corresponding special technical features for the following reasons: they lack the same or corresponding special technical features. Groups I-VIII are directed to compositions which all have different structural features which are responsible for their functional features. The two proteins are different, therefore they have different structure. The nucleic acid molecules which encode them also have different structures as well as different structures from the proteins based on the nature of nucleic acids versus amino acids. The effector molecules will depend on the nature of the molecules they are effecting, therefore, they lack a special technical feature with the other molecules.

According to PCT Rule 13.2, unity of invention exists only when the shared same or corresponding special technical feature defines a contribution over the prior art. Groups IX-XIV are directed to using various compositions of Groups I-VIII. However, these methods lack unity of invention with the compositions because the international search report indicated that the invention of claim 1 was known in the prior art of WO 02/074956. Therefore, the compositions of the proteins of DG153 or DG177 (or the nucleic acid molecules) cannot serve as the basis for unity of invention because the technical feature of DG153/DG177 does not define a contribution over the prior art.

Groups XV-XVIII are directed to additional products and lack unity of invention with Groups I-XIV. 37 CFR 1.475 does not provide for the inclusion of multiple inventions. If multiple products, processes of manufacture or uses are claimed, the first invention of the category first mentioned in the claims will be considered the main invention (see PCT Article 17(3)(a)). Accordingly, the inventions of Groups XV- XVIII do not have unity of invention with the compositions of Groups I-VIII.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b)

Art Unit: 1647

if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may**

Art Unit: 1647

result in a loss of the right to rejoinder. Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christine J. Saoud whose telephone number is 571-272-0891. The examiner can normally be reached on Monday-Friday, 6AM-2PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Manjunath Rao can be reached on 571-272-0939. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christine J Saoud/
Primary Examiner, Art Unit 1647

